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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application/Reexamination of: **URANO et al.**

U.S. Patent No.: **5,216,135**

Reexamination Control No.: **90/004,812**

Filed: **October 23, 1997**

Reissue Serial No.: **09/810,650**

Group Art Unit: **1626**

Issue Date: **June 1, 1993**

Examiner: **Laura Lynne Stockton**

P.T.O. Confirmation No.: **8670**

For: **DIAZODISULFONES**

AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

December 30, 2002

Sir:

In response to the Office Action dated **September 6, 2002**, extended to **January 6, 2003** by a **2** month Petition for Extension of Time, please amend the above-identified application as follows:

IN THE CLAIMS:

Please add the following new claim 10:

10. (New) A diazodisulfone compound of the formula:

$$\begin{array}{c} R^1SO_2CSO_2R^2 \\ \| \\ N \end{array}$$

wherein R^1 is cyclohexyl; and R^2 is cyclohexyl.

REMARKS

Claims 8 and 9 have been rejected; claim 7 has been indicated to be in condition for allowance; and claim 10 has been added to more particularly and distinctly claim the subject matter to which the Applicants regard as their invention. It is believed that this Amendment is fully responsive to the Office Action dated **September 6, 2002**.

Essentially, the Examiner has maintained the rejection of claims 8 and 9 for the same reasons as in the previous Office Action. According to the Examiner, those claims lack written description support in the Japanese priority application and are therefore invalid over the ***Pawlowski*** patent; also, the Examiner states that claims 8 and 9 lack written description support in the present U.S. application and are therefore invalid under 35 U.S.C. §112, first paragraph. Applicants respectfully submit that the Examiner's position is not supported by the relevant facts and is contrary to the relevant law. Specifically, both the U.S. application and the Japanese priority application support the pending claims and ***Pawlowski*** is therefore not prior art.

I. The Examiner's Position

The Examiner states that the definitions of the two R groups in the formulas of claims 8 and 9 are not supported by the U.S. specification, though there is no explanation of why those R group definitions are not supported.[1]

The Examiner then states that she is responding to Applicants' arguments presented in the

[1] *See* MPEP §706.03(c) regarding such explanations.

Amendment filed May 22, 2002. She states that "Applicants have not pointed out where the claimed subject matter is described *as such* in the specification." (Emphasis added). The Examiner does not reply to the detailed explanation on page 7 of the Amendment of the support in the U.S. application, which explanation is incorporated herein by reference. Also, the Examiner dismisses the Tockman Declaration filed May 22, 2002 because it does not address the issue of support for the claims in the U.S. application.[2]

Finally, the Examiner states that she is replying to Applicants' argument that the claims are valid over the prior art because they are supported by the U.S. application and the priority application and therefore ***Pawlowski*** is not prior art against the present claims. The Examiner states merely that claims are not supported by the U.S. application or the priority application. The only explanation offered for this conclusion is the Examiner's reference to the CAFC decision regarding claims 2 and 3 which recited clearly different subject matter from the present claims and have been canceled.

II. Applicants' Response

Applicants respectfully submit that their claims are supported by the earlier applications and that ***Pawlowski*** is not prior art. Applicants believe that the pending rejections are incorrect for the following reasons.

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[2] The Tockman Declaration addressed only the Japanese application because the written description support was clearer in the U.S. application, *i.e.*, if there is support in the Japanese application, there is also support in the U.S. application.

First, the Examiner states that the claims lack support in both the U.S. and the Japanese applications, but fails to explain why there is no support.

Second, as indicated above, the Examiner uses the expression "as such" in the last line of page 2 of the Action. The expression shows that the Examiner is requiring that the precise words of the claims also appear in the applications, to satisfy the written description requirement. Such a requirement is a clear violation of precedent. If the essence of the original disclosure supports the new claim limitation, the new limitation is not new matter. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). *Ipsis verbis* support is not necessary.

Third, claims 8 and 9 are quite different from claims 2 and 3. Accordingly, the Examiner cannot rely upon the CAFC decision regarding claims 2 and 3 to reject claims 8 and 9. Each claim of patent must be separately analyzed for compliance with the written description requirement. *Vas-Cath Inc. v. Nahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

Fourth, the Examiner fails to address the comments in the Tockman Declaration regarding the support in the Japanese application. In the present Declaration, in which Dr. Tockman repeats his earlier remarks regarding the Japanese application and adds remarks regarding the U.S. application and claim 10, he makes the following critical points.

A. The definition of R^1_0 and R^2_0 in formula [1] of the Japanese Patent application is inclusive of "a C_{1-10} straight-chain, branched or cyclic alkyl group." (Page 9). R^1_0 and R^2_0 are further defined at page 14 of that Application (as translated) as inclusive of "methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group."

B. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are a cyclohexyl group (claim 8) and where both of R^1_0 and R^2_0 are a branched butyl group (claim 9).

C. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47) (in the case of claim 8), and R^1 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:33-34) and R^2 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:43-44) (in the case of claim 9).

D. The compound of claim 10 is compound of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are cyclohexyl.

E. The compound of claim10 is compound of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47).

F. Based on his extensive experience in matters relating to the synthesis of organic compounds, it is his opinion that a person having an undergraduate degree in chemistry and several years experience in synthesizing organic compounds would know that "a C_{1-10} straight-chain, branched or cyclic alkyl group" is shorthand for and inclusive of each and every such alkyl group have 1-10 carbon atoms. This is particularly the case in view of the further description of the straight-chain, branched or cyclic alkyl group at page 14 of the Japanese application.

G. Based on his extensive experience in the matter relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience synthesizing organic compounds would know that the category of a branched butyl is synonymous with an "isobutyl group, a sec-butyl group or a tert-butyl group."

H. It is his further opinion that the Japanese patent Application establishes to an organic chemist of ordinary skill in the art that the inventors in the Japanese Patent Application were in possession of the compounds described in claims 8, 9 and 10.

I. It is also his opinion that U.S. Patent No. 5,216,135 establishes to an organic chemist of ordinary skill in the art that inventors in the '135 patent were in possession of the compounds described in claims 8, 9 and 10.

For each of the above reasons, Applicants submit that their claims are patentable over the prior art and supported by the specification.

III. Conclusion

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

Scott M. Daniels
Attorney for Applicants
Reg. No. 32,562

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Washington, D.C. 20006
(202) 659-2930

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PATENT TRADEMARK OFFICE

Enclosures: Declaration of Al Tockman
Q:\FLOAT\FRS\SMD\910094RE and RI\Response to 2nd OA 12-23-02 (RE)

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P.T.O. Confirmation No.: **8670**

For: **DIAZODISULFONES**

PETITION FOR EXTENSION OF TIME

Commissioner for Patents
Washington, D.C. 20231

Date: December 30, 2002

Sir:

Applicants petition the Commissioner for Patents to extend the time for response to the Office Action dated September 6, 2002 for two months from November 6, 2002 to January 6, 2003.

Attached please find a check in the amount of $400.00 to cover the cost of the extension for a large entity. In the event that any additional fees are due in connection with this paper, please charge our Deposit Account No. 01-2340. Two copies of this paper are enclosed herewith.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

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CERTIFICATE OF SERVICE

Commissioner for Patents
Washington, D.C. 20231

Date: December 30, 2002

Sir:

Applicants submit that a copy of the Petition for Extension of Time and Amendment filed with the U.S. Patent and Trademark Office on December 30, 2002, in the above captioned matter, was served by U.S. Mail, postage pre-paid, on the Requestor in the matter at the following address:

JUDITH A. EVANS
JONES & VOLENTINE
12200 Sunrise Valley Drive - Suite 150
Reston, Virginia 20191

Respectfully submitted,

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